UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/098,562	03/18/2002	Masatsugu Koguchi	325772028200	3154

7590 09/22/2005

Barry E. Bretschneider
Morrison & Foerster LLP
Suite 5500
2000 Pennsylvania Avenue, N.W.
Washington, DC 20006-1888

EXAMINER	
PATEL, ASHOKKUMAR B	
ART UNIT	**PAPER NUMBER**
2154	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/098,562	KOGUCHI, MASATSUGU	
	Examiner	Art Unit	
	Ashok B. Patel	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 July 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1. Claims 1-13 are presented for examination.

Response to Arguments

2. Applicant's argument:

"Claim 1 recites "request means for requesting that a recipient to which the image data stored in the storage device is to be sent designates contents of conversion processes to be performed to the image data." The Examiner has failed to set forth where either Ida or Merritt disclose or suggest this feature. Thus, the Examiner has failed to set forth a prima facie case of obviousness. The Examiner is requested to point out where either Ida or Merritt disclose this feature or withdraw the rejection."

Examiner's response:

First of all Examiner apologizes for failing to point out the claimed element . Please refer to the following rejection of claim 1 for details.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 2, 5, 7-9, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ida et al. (EPO Patent Application EP 1022894 A1, "Ida") in view of Merritt et al, (US 6,421,429 131, "Merritt").

Referring to claim 1,

As per claim 1, Ida teaches a data transmission apparatus for transmitting image data over a network, the data transmission apparatus comprising: an image reader for obtaining image data by reading an original document (Fig. 1, facsimile machines; Paragraph 0022); a storage device in which the image data obtained is stored (Paragraph 0044; image date compressed to a file); request means for requesting that a recipient to which the image data stored in the storage device is to be sent designates contents of conversion processes to be performed to the image data;(col. 5, para. [0029],[0030],[0049]); a receiving means for receiving recipient's designation of the contents of the conversion processes to be performed to the image data (Paragraph 0049; transmission of message designating capability information of recipient; Paragraph 0051; mail server receives message); conversion means for, based on the contents of the conversion processes designated, performing the conversion processes to the image data stored in the storage device (Paragraph 0068); and transmission means for sending to the recipient the image data that has undergone the conversion processes (Paragraph 0068).

Ida fails to explicitly teach a second receiving means for receiving the recipient's designation of the contents of the conversion processes via a transmission medium different from that used by the first receiving means; switching means for switching receiving means that receives the recipient's designation of the contents of the conversion processes to the first or second receiving means depending on the recipient.

Merritt teaches providing a first (col. 7, lines 10-15: query database for profile

designating conversion process for users which are subscribers) and a second means for receiving the recipients designation of the contents of the conversion process using different transmission medium for each means and switching the receiving means depending of the recipient (col. 7, lines 49-55; request communication of conversion format via email for non subscribers).

It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Merritt and Ida because they both with converting image data to a recipients designated format. Furthermore, the teaching of Merritt to provide a first and second means for receiving conversion process designation increase the applicability and efficiency of the process by allowing the format to be designated without network traffic when the information is registered while allowing the process to be determined when the recipients preference is not previously known.

Referring to claim 2,

As per claim 2, Ida and Merritt as applied to claim 1 teaches a data transmission apparatus according to claim 1, wherein the request means have mail transmission means for sending an e-mail to request the recipient's designation of the contents of the conversion processes (col. 7, lines 49-55; request communication of conversion format via email for non subscribers).

Referring to claim 5,

As per claim 5, Ida teaches a data transmission apparatus according to claim 1, wherein the conversion processes include at least a resolution conversion process, a color conversion process or a file format conversion process (col. 4, lines 25-32).

Referring to claim 7,

As per claim 7, claim 7 recites the method carried out by the apparatus recited in claim 1 and is rejected for the same reasons as claim 1.

Referring to claim 8,

As per claim 8, claim 8 recites a data transmission program which when executed by a computer carries out the method carried out by the apparatus recited in claim 1. Ida teaches implementing the apparatus in a computer via instructions stored on a computer readable medium (Paragraph 0018 and 0019). Claim 8 is rejected for the same reason as claim 1.

Referring to claim 9,

Claim 9 is rejected for the same reason as claim 2 above.

Referring to claim 13,

Claim 13 is a product claim reciting the same subject matter as claim 8, and is rejected for the same reasons as claim 8.

5. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ida and Merritt as applied to claims 2 and 9 above, and further in view of Gilmour (US 6,647,384 B2, "Gilmour").

Referring to claims 3 and 10,

As per claims 3 and 10, Ida teaches a first receiving means consisting designating the contents of the conversion process via an email message from the recipient (Paragraph 0049; transmission of message designating capability information of recipient; Paragraph 0051; mail server receives message).

Ida does not explicitly teach wherein the first receiving means receive the recipient's designation of the contents of the conversion processes based on an instruction sent from the recipient via a setting screen that is used to designate the contents of the conversion processes and that was referred to by the recipient based on information that was attached to the e-mail and indicates location of data for the setting screen, and wherein the second receiving means receive the recipient's designation of the contents of the conversion processes via an e-mail that was returned from the recipient in response to the e-mail sent by the mail transmission means.

Gilmour teaches alternative receiving means for responding to an email requesting profile information including a first means of receiving a response via email and a second means of receiving a response by means of a link included in the email which directs the user to a cite for entering the profile information (col. 19, lines 26-33).

It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Gilmour and Ida because they both deal with requesting information specific to a recipient. Furthermore, the teaching of Gilmour to modify the method of designating the required conversion process as taught by Ida to provide a first method of responding by email and a second method of responding via a web page link provided in an email would allow the system to be used more universally by providing a more universal method for users whose systems do not support email links while providing a user friendly GUI method for those users on more capable systems.

6. Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ida, Merritt and Gilmour as applied to claims 3 and 10 above, and further in view of 'Official Notice'.

Referring to claims 4 and 11,

As per claims 4 and 11, Ida fails to explicitly teach wherein, the transmission medium is set to the first transmission medium when a domain name in an e-mail address of the recipient is identical to a domain name in an e-mail address of a sender, and the transmission medium is set to the second transmission medium when the domain name in the e-mail address of the recipient is different from the domain name in the e-mail address of the sender.

However the office takes 'Official Notice' that it is well known in the art that some email systems do not support links in e-mails to direct the recipients to a web page. The unknown capability of an unknown system may preclude presuming that an external system, that is one with a recipient system in a different domain than the sender's system can support such links, while the sender's system may be known to support them.

It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching use the first transmission medium on a know system with the same domain name as the sender's system while using the second transmission medium when the sender and recipient domain names differ because doing so would allow the system to be used more universally by providing a

more universal method for users whose systems do not support email links while providing a user friendly GUI method for those users on more capable systems.

7. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ida and Merritt as applied to claims 1 and 8 above, and further in view of Picoult et al. (US 6,654,601 B2, "Picoult").

Referring to claims 6 and 12,

As per claims 6 and 12, Ida does not explicitly teach further comprising recipient change receiving means for receiving an instruction to change the recipient, and wherein the transmission means send the image data that has undergone the conversion processes to a new recipient when the recipient is changed.

Picoult teaches recipient change receiving means for receiving an instruction to change the recipient, and wherein the transmission means send the image data that has undergone the conversion processes to a new recipient when the recipient is changed (col. 4, lines 20-25; image data is converted; cal. 4, lines 3-5; recipient designates where message will be retrieved).

It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Ida and Picoult to allow receiving an instruction to change the recipient and to send the converted message to the recipient because they both deal with performing conversion of image data to a format designated by the recipient. Furthermore, the teaching of Picoult to allow changing of the message recipient would increase the flexibility of the system by increasing the range of devices to which the image data could be sent (See Picoult, col. 5, lines 5056).

Conclusion

Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok B. Patel whose telephone number is (571) 272-3972. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Abp

JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100